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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,525	06/26/2003	Giacomo Digrigoli	2043.114US1	9327
49845 7590 06/26/2009 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER POINVIL, FRANTZY				
ART UNIT 3696		PAPER NUMBER		
NOTIFICATION DATE 06/26/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary

Application No.

10/608,525

Applicant(s)

DIGRIGOLI ET AL.

Examiner

Frantzy Poinvil

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 3/16/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/16/2009 have been fully considered but they are not persuasive.

Regarding claims 1, 24, 34, 36 Applicant's representative argues that Boesch fails to teach or suggest "the user interface to enable a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance of the payment in the sender-selected currency and a denial of the payment in the sender selected currency". Applicant's representative also argues that Boesch fails to teach and or suggest the limitation of "receiving from the recipient via the communications network data indicating a recipient decision with respect to an acceptance of the payment in the sender-selected currency" as recited in independent claims 13, 31, 35 and 37. Applicant's representative further states that Boesch states that "[It] is not required that the merchant user 303 knows or approve the customer selected currency, that is the currency in which the customer user 203 will pay" and cites column 7, lines 60-63 of Boesch for support.

In response, Boesch does state that "it is not required that the merchant user 303 knows or approve the customer selected currency, that is the currency in which the customer user 203 will pay". However, in the preceding paragraph, Boesch states "In a further aspect of this embodiment, we prefer that along with providing the amount in the customer selected currency A (CSC), the customer computer

200 also transmit the agreed price in the merchant accepted currency P(MAC) to the server 100. This assures that the customer user 203 and the merchant user 303 have actually reached agreement on the terms of the transaction and precludes either party from denying such agreement. Other information may be transmitted by the customer computer 200 as needed by the server, for example, a requested payment range (described later), information identifying the customer user 203, the product to be purchased, account information, etc. ".

Thus from this teaching, it is clearly noted that Boesch teach the claimed function of :

"if receiving a confirmation of the payment in the sender-selected currency from the sender, informing a recipient via the communications network about the payment in the sender-selected currency, the informing the recipient via the communications network including communicating a user interface to the recipient, the user interface to enable a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance of the payment in the sender-selected currency and a denial of the payment in the sender-selected currency".

Thus, applicant's arguments are not convincing.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesch et al. (US Patent No. 5,897,621).

As per claims 1-39, Boesch et al disclose a system and method for processing payment transactions in a multi-currency payment system. The system and method comprise communicating to a sender via a communications network a user interface that facilitates sender input with respect to a desired currency in which a payment is to be made; receiving data identifying a sender-selected currency from the sender via the communications network; communicating to the sender via the communications network information identifying a current exchange rate for conversion between the sender-selected currency and a sender primary currency. Applicant is directed to column 7, line 7 to column 9, line 25.

Boesch et al further disclose the sender primary currency is a currency used in a majority of transactions involving the sender and wherein the payment is to fund from a balance in the sender-selected currency that is maintained within a sender account. See column 5, lines 44-64 and column 6, lines 20-31 and lines 44-49 of Boesch et al.

Boesch et al also teach determining that the sender does not have a balance in the sender selected currency within the sender account and converting an equivalent value in the sender

primary currency into the sender-selected currency to fund the payment. See column 6, lines 20-31, column 4, lines 8-45 and column 10, lines 29-65 of Boesch et al.

Applicant has amended the independent claims 1, 34 and 36 to recite that enabling a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance of the payment in the sender-selected currency and a denial of the payment in the sender selected currency and argues that Boesch et al fail to teach or suggest this limitation.

In response, Boesch et al do not explicitly recite the exact language recited in the applicant's independent claims. It is noted that Boesch et al are directed to a commerce system in which a customer in a given type currency provides payment to a merchant for the purchases of goods and/or services. Both the customer and the merchant agree to the currency pair being used. See the abstract of Boesch et al.

Boesch et al state that the merchant is willing to accept payment in a currency different than that of the customer. See the abstract and column 6, lines 11-19. Furthermore, it would have been obvious to one of ordinary skill in the art to note at the time the invention was made that if the customer selects a currency not acceptable by the merchant, the merchant would have sent a notification to the customer informing the customer of an unacceptable selection of a currency by the customer. Therefore, denying acceptance of the sender selected currency and resulting in informing the recipient of a denial of the payment in the sender selected currency would have been done by either the merchant or the server of the system of Boesch et al.

Regarding claims 13, 31, 35 and 37, applicant's representative argues that the function of receiving from the client or recipient an indication or decision with respect to an acceptance of the payment in the sender-selected currency, and to notify the sender via the communications network of the recipient decision.

In response, it is noted that Boesch et al are directed to a system and method for multi-currency transactions. The system and method comprise a remote customer accessing a merchant website to purchase goods in one currency and to perform payment transactions with another currency acceptable by the merchant. See the abstract. The customer and merchant have contracted to transact with particular currency pairs. See column 6, lines 32-49 or Boesch et al. Thus, the Examiner notes that if the sender or customer uses a currency that may not be acceptable by the merchant, the customer or client must inform or notify the merchant and in return the merchant must provide an indication of acceptance or denial or the currency the client or sender intends to use. Thus, these steps taken by the customer and merchant would have been obvious steps taken by the one having ordinary skill in ordinary business practice so that both parties (the customer and merchant) agree in the type of currencies to be used for the payment of a purchase transactions.

Boesch et al also disclose updating the current exchange rate at predefined time intervals and upon determining that a predefined time interval has expired, retrieving current exchange rates from a third party system, applying a set of rules to the retrieved rates to verify that the retrieved rates are correct and replacing existing rates are correct and replacing existing rates stored in a database with the retrieved rates. See column 8, line 49 to column 9, line 3.

Boesch et al also disclose accumulating payment transactions in each of a plurality of currencies used during the predefined time interval; requesting the third party system to trade the accumulated payment transactions and receiving confirmation from the third party system that trades of the accumulated payment transactions have been completed. See column 14, lines 14-40.

Functions of determining that the recipient did not accept the payment in the sender-selected currency and displaying an error message to the sender offering the sender to select a different currency for the payment to provide an interactive session to the involved parties are inherent features in the system of Boesch et al.

The computerized system stores all transactions involved all clients that are stored for inventory control and dispute resolution purposes. Thus, a history of currency conversion calculations from previous transactions involving the sender is an inherent feature in the system of Boesch et al.

Boesch et al also disclose determining whether a recipient requests a conversion of the payment account into the recipient primary currency, and if not creating a new balance in the sender-selected currency within the recipient account and adding the payment amount to the new balance. See column 4, lines 8-45.

Boesch et al also teach that payments will be block for which the recipient does not have a balance.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3696**

FP
June 1, 2009